

**REMARKS**

Reconsideration of this application is respectfully requested.

**I. Status of the Claims**

Claims 1, 8, and 18 have been amended, no new matter is added.

Claim 3 has been cancelled without prejudice or disclaimer of the subject matter therein.

Claims 1, 2 and 4-18 are pending.

Claim 8 has been objected to for containing a misspelling, Applicant has corrected the informality and requests that the objection be withdrawn.

**II. Acknowledgement of Allowable Subject Matter**

Applicant thanks the Examiner for the acknowledgment that claim 18 is allowable if amended in independent form. Applicant amended claim 18 and placed the claim in condition for allowance.

**III. Rejections under 35 U.S.C. § 102**

Claims 1, 2, 4, 12-14 and 16 are rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,121,686 to Schonlau et al. ("Schonlau"). Applicant has amended claim 1 to include the features of claim 3, wherein "the piston comprises ... at least one material from the group consisting of polytetrafluoroethylene, molybdenum disulfide, and graphite." This element is not taught or suggested by Schonlau. Further, claims 2, 4, 12-14 and 16 all depend from claim 1 and are allowable based at least on their dependency to the independent claim. Applicant respectfully requests that the rejection be withdrawn.

**IV. Rejection under 35 U.S.C. § 103**

Claims 3 and 8 are rejected under 35 U.S.C. § 103(a) as unpatentable over Schonlau in view of U.S. Patent No. 6,526,868 to Winkelmann et al. ("Winkelmann"). Claims 5-7 are rejected under 35 U.S.C. § 103(a) as unpatentable over Schonlau in view of U.S. Patent No. 5,767,198 to Shimizu et al. ("Shimizu"). Claims 9-11 are rejected under 35 U.S.C. § 103(a) as unpatentable over Schonlau in view of the Examiner statement of Engineering Expedient. Claim 15 is rejected under 35 U.S.C. § 103(a) as unpatentable over Schonlau in view of the Examiner statement of Design Choice. Claim 17 is rejected under 35 U.S.C. § 103(a) as unpatentable over Schonlau in view of U.S. Patent No. 5,715,681 to Williamson. Applicant respectfully traverses the rejection.

With respect to claims 3 and 8, Applicant submits that Winkelmann is not prior art to this application. Set forth on page 3 of the Office Action is the statement:

The applied reference (6526868) has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 C.F.R. 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the


inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). *For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(1)(1) and § 706.02(1)(2). (Emphasis added)*

With respect to Winkelmann, Applicant respectfully asserts that the subject matter of Winkelmann and the claimed invention were, at the time the invention was made, subject to an obligation of assignment to the same person. As evidence of this, Applicant has enclosed the recorded assignment of the present application (as Exhibit A), as well as the relevant pages of the two recorded assignments of the parent of the Winkelmann patent, U.S. Patent No. 6,446,436 (as Exhibit B). Winkelmann is a divisional of the '436 patent and is subject to the same assignment as the '436 patent. Additionally, please note that the second Assignment only changed the name of the assignee. Therefore, Winkelmann does not qualify as prior art. Further, Schonlau, Williamson, and Shimizu do not, alone or in combination, teach or suggest the elements of claims 3 and 8 and thus, claims 3 and 8 contain allowable subject matter. Accordingly, claim 1 has been amended to contain the subject matter of claim 3 and claim 8 has been amended to be in independent form.

Claims 5-7, 9-11, 15, and 17 all depend from claim 1 and are allowable based at least on their dependency to the independent claim. Applicant respectfully requests that the rejection be withdrawn.

In view of the above amendment, Applicant believes the pending application is in condition for allowance.

Respectfully submitted,

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